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REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1, 2, and 4-17 are pending in this application. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action, claims 1, 2, and 5-17 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,760,759 to Chan ("Chan"). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan in view of U.S. Patent No. 6,185,198 to LaDue ("LaDue"). Applicants respectfully traverse the rejections.

Applicants respectfully submit that the cited portions of Chan do not disclose, teach, or suggest the features recited in the claims. Further, the Examiner refers to broad portions of the disclosure of Chan and does not particularly and clearly identify the elements of Chan that are believed by the Examiner to anticipate the features in the claims. Such broad identification does not reasonably apprise Applicants of the portions of the system of Chan that are considered by the Examiner to anticipate the claims, as required by MPEP § 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity"). For at least this reason, and for the reasons that follow, the rejections under 35 U.S.C. § 102(e) are improper and Applicants respectfully request clarification and an opportunity for a proper response by making a subsequent action, if such action is necessary, non-final.

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For example, in claim 1, for the claimed feature of "receiving, at a remote server, one or more search parameters from the wireless device, the one or more parameters different from a menu navigation command of the wireless device," the Examiner states "refer to Col 4, Lines 40-60" (with no further explanation) as the sole support for this element. The cited portion of Chan is a general description of the connectivity of a handheld device to a server, including a brief mention of a search engine. There is no reference therein of the reception at a remote server of one or more search parameters that are different from a menu navigation command of the wireless device. Chan is silent as to any of the parameters that may or may not be received by a server and, at the least, the Examiner has not met the burden of a *prima facie* showing of anticipation since no specific elements of Chan have been cited as meeting the elements in the claim.

With respect to the feature in claim 1, "identifying a folder based on the one or more search parameters, wherein the identified folder is part of a preexisting deck maintained by said remote server," the Examiner states, "refer to Col 4, Lines 60-67" (with no further explanation) as the sole support for this element. The cited portion of Chan relates to a mapping server (46, in Figure 2 of Chan) that tracks and updates data that is stored in the 20/80 RIDB. The 20/80 RIDB is a *local database* (i.e., the database is located in the handheld device itself) that is designed to provide users with ready, network-independent access to information that is most wanted by the user and is user-specific. The mapping server of Chan is not disclosed as maintaining a preexisting deck from which a folder is identified based on one or more search parameters. As such, the cited portions of Chan do not disclose, teach, or suggest claim 1 and, at the least, the

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Examiner has not met the burden of a *prima facie* showing of anticipation since no specific elements of Chan have been cited as meeting the elements in the claim.

With respect to the feature in claim 1, "communicating the identified folder to said wireless device for performing a menu navigation to the identified folder," the Examiner states "refer to Col 5, Lines 35-63" (with no further explanation) as the sole support for this element. The cited portion of Chan is a description of the "speedy search application" that is resident *on the handheld* (col. 5, lines 35-37 of Chan) and does not disclose, teach, or suggest the communication of the identified folder (that is part of a preexisting deck maintained by the remote server) to a wireless device. Although a search may be "submitted to the search engine resident on the server" (col. 5, lines 54-55 of Chan), Chan is nonetheless silent as to an identified folder that is part of a preexisting deck maintained by the server. Chan describes the server as obtaining information at a location provided by an ICP (col. 5, lines 57-60) and therefore does not maintain a preexisting deck from which a folder is identified. Accordingly, the cited portions of Chan do not disclose, teach, or suggest claim 1 and, at the least, the Examiner has not met the burden of a *prima facie* showing of anticipation since no specific elements of Chan have been cited as meeting the elements in the claim.

To the extent that the Examiner attempts to rely on inherent teachings of Chan, Applicants respectfully note that to establish inherency, it must be shown that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. See MPEP § 2112.IV. Accordingly, where the Examiner relies on parts of Chan that are silent or ambiguous as to elements of the claims, it is

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not enough to be *possible* that Chan performs the invention as claimed; the missing elements must *necessarily* be present in order to anticipate.

Each of the other independent claims, 5 and 10, recite similar language to that of claim 1 and Chan fails to disclose, teach, or suggest such features for at least the same or similar reasons as set forth above. Further, the Examiner likewise does not particularly identify the elements of Chan that are asserted to anticipate the recited claim elements and therefore, at the least, the Examiner has not met the burden of a *prima facie* showing of anticipation. Accordingly, Applicants respectfully submit that each of the independent claims 1, 5, and 10 are patentable over Chan.

Claims 2, 6-9, and 11-17 are patentable over Chan at least by virtue of their dependency from claims 1, 5, and 10 and for the additional features recited therein.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, and 4-17 under 35 U.S.C. § 102(e) based on Chan.

With respect to rejection of claim 4 under 35 U.S.C. § 103(a), Applicants respectfully submit that LaDue does not cure the deficiencies of Chan. LaDue discloses a system for transmitting and receiving wireless data messages and does not disclose, teach, or suggest the claimed features related to a wireless search method and device. Claim 4 is therefore patentable over Chan by virtue of its dependency from claim 1 as discussed above and is further patentable over Chan and LaDue, alone or in combination, since LaDue does not cure the deficiencies of Chan. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 4.

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In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

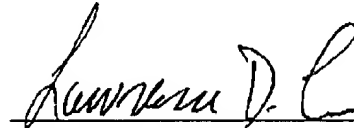
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Respectfully submitted,

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